REMARKS/ARGUMENTS

The Examiner is thanked for the performance of a thorough search. By this amendment, Claim 1 has been amended. No claims have been added, cancelled, or amended. Hence, Claims 1-46 are pending in the application.

SUMMARY OF THE REJECTIONS/OBJECTIONS

Claims 1-6, 8-9, 11-29, 31-32 and 34-46 were rejected under 35 U.S.C. § 102(b) as being unpatentable over U.S. Patent Application Publication No. 2002/0062258 to Bailey et al. ("*Bailey*")

Claims 7 and 30 were rejected under 35 U.S.C. § 103(a) as being unpatentable over *Bailey* in view of U.S. Patent Application Publication No. 2006/0184430 to Gavarini et al. ("*Gavarini*").

Claims 10 and 33 were rejected under 35 U.S.C. § 103(a) as being unpatentable over *Bailey* in view of U.S. Patent Application Publication No. 2002/0062258 to Scholl et al. ("*Scholl*").

Claims 24-46 were objected to under 37 C.F.R. 1.75(c) as being of improper dependent form for failing to further limit the subject matter of previous claim.

NON-PRIOR-ART OBJECTIONS/REJECTIONS

Claims 24-46 were objected to under 37 CFR 1.75(c) as being of improper dependent form for failing to further limit the subject matter of a previous claim. This objection is respectfully traversed.

Claims 24-46 further limit the subject matter of the claims on which they depend because the claims on which they depend cover both hard-wired and software-based implementations of the recited methods. Claims 24-46, on the other hand, limit coverage to only software-based implementations (i.e. implementations in which a processor reads and executes instructions from a computer-readable medium). Since Claims 24-46 cover only a subset of those implementations covered by the claims on which they depend, they clearly further limit the subject matter of the claim on which they depend.

With respect to this objection, it is recognized that it is uncommon for a dependent claim to have a different form than the claim on which it depends. However, such a practice is explicitly authorized by the MPEP. In fact, many patents have issued with this exact form of dependent claim, including:

6,711,567 Delivering non-default items in association with search results
6,661,877 System and method for providing access to a unified message store logically storing computer telephony messages
6,647,510 Method and apparatus for making available data that was locked by a dead transaction before rolling back the entire dead transaction
6,633,891 Managing replacement of data in a cache on a node based on caches of other nodes
6,631,371 Database fine-grained access control
6,130,677 Interactive computer vision system
6,031,934 Computer vision system for subject characterization

In all of these cases, the USPTO ultimately found the claims to be in proper dependent form. However, due to the uncommon nature of such claims, it was necessary in at least one previous case to set forth a detailed explanation of the propriety of such claims. That argument is reproduced hereafter. It should be noted that the claim at issue in that prior case was a computer-readable medium Claim 24 which depended on an independent method Claim 1. Claims 24-46 have the identical form of Claim 24, so the explanation provided hereafter applies equally to the present claims 24-46.

DETAILED EXPLANATION OF PROPRIETY OF CLAIM

Various tests have been established to determine whether a particular claim qualifies as a proper dependent claim. Significantly, none of the tests requires the dependent claim to fall within the same statutory class as the claim on which it depends. Specifically, MPEP § 608.01(n) states, among other things:

> **"The fact that the independent and dependent claims are in different statutory classes does not, in itself, render the latter improper.** Thus, if claim 1 recites a specific product, a claim for the method of making the product of claim 1 in a particular manner would be a proper dependent claim since it could not be infringed without infringing claim 1. Similarly, if claim 1 recites a method of making a product, a claim for a product made by the method of claim 1 could be a proper dependent claim."

TEST #1: CLAIM 24 IS PROPER UNDER 35 U.S.C. § 112

35 U.S.C. § 112 is the statutory section that sets for the requirements of a proper dependent claim. In paragraph 4, 35 U.S.C. § 112 states:

> Subject to the following paragraph, a claim in dependent form shall **contain a reference to a claim previously set forth** and then **specify a further limitation of the subject matter claimed**. A claim in dependent form shall be construed to incorporate by reference all the limitations of the claim to which it refers.

The first sentence of this paragraph sets forth the two requirements for a proper dependent claim, and the second sentence sets forth the legal significance to the dependency.

With respect to the requirements, a proper dependent claim must (1) contain a reference to a claim previously set forth, and (2) specify a further limitation on the subject matter claimed. Both of these requirements are clearly satisfied by Claim 24. Specifically, Claim 24 clearly contains a reference to Claim 1. In addition, Claim 24 specifies the further limitation that instructions for performing the method of Claim 1 must stored on a computer-readable

medium, so that the method would be performed when one or more processors execute the instructions. Since Claim 1 does not itself require that the method be performed by executing stored instructions, the limitation added by Claim 24 qualifies as a further limitation.

Because Claim 24 is a proper dependent claim, the second sentence of 35 U.S.C. § 112, fourth paragraph indicates that it is to be construed to incorporate by reference all the limitations of the claim to which it refers. Thus, in the present case, Claim 24 is to be construed to incorporate all limitations of the method set forth in Claim 1. That interpretation of Claim 24 is consistent with Applicant's understanding of Claim 24. Specifically, to infringe Claim 24, a computer readable medium would have to include instructions for each and every step recited in the parent Claim 1.

TEST #2: CLAIM 24 IS PROPER UNDER 37 C.F.R. § 1.75(c)

37 C.F.R. § 1.75(c) states:

> "One or more claims may be presented in dependent form, referring back to and further limiting another claim or claims in the same application...."

The test set forth in 37 C.F.R. § 1.75(c) is merely an abbreviated restatement of the test set forth 35 U.S.C. § 112, fourth paragraph. As explained above, Claim 24 refers back to Claim 1, and introduces limitations that are not present in Claim 1. Consequently, Claim 24 satisfies the 37 C.F.R. § 1.75(c) for the same reasons that it satisfies the 35 U.S.C. § 112, fourth paragraph test.

TEST #3: CLAIM 24 IS PROPER UNDER MPEP § 608.01(n)

MPEP § 608.01(n) states:

"the test as to whether a claim is a proper dependent claim is that it shall include every limitation of the claim from which it depends (35 U.S.C. 112, fourth paragraph) or in other words that it shall not conceivably be infringed by anything which would not also infringe the basic claim."

Unfortunately, the MPEP test involves a circular reasoning, and is therefore less useful than the tests set forth in the relevant statute and rules. Specifically, the MPEP test indicates that incorporation of all of the limitations of the base claim is what determines whether a claim is a dependent claim. However, the statute clearly dictates that, by virtue of a claim being dependent, the claim must be construed to incorporate all of the limitations of the base claim.

However, in spite of the difficulty posed by this circular reasoning, it is respectfully submitted that Claim 24 is also proper under the MPEP test. As mentioned above, it is fully intended that Claim 24 incorporate all of the limitations of Claim 1. In other words, to infringe Claim 24, a computer readable medium must include instructions for performing each and every limitation recited in Claim 1.

To the extent that the three tests would yield different results, it is respectfully submitted that the outcome of the test set forth in the statute should govern. However, in the present case, it is respectfully submitted that all tests yield the same results; namely, that Claim 24 is a proper dependent claim. Thus, withdrawal of the 37 C.F.R. § 1.75(c) rejection is respectfully requested.

THE REJECTIONS BASED ON THE PRIOR ART

Claims 1-6, 8-9, 11-29, 31-32 and 34-46 were rejected under 35 U.S.C. § 102(b) as being unpatentable over *Bailey*. Claim 1 contains features not taught or anticipated by the cited prior art, therefore the rejection is respectfully traversed. Claim 1 recites:

A method for associating data with product abstractions comprising the steps of:
inspecting a first data set that includes data that corresponds to an offer to sell a particular product by a particular party;
based on the first data set, assigning said particular product to a product category; and
matching said first data set with a product abstraction based, at least in part, on the product category to which said particular product corresponds.

The first limitation of Claim 1 not taught or suggested by the prior art is "**based on the first data set, assigning said particular product to a product category.**" *Bailey* describes a system for parametrically searching a database of products belonging to various categories and generating product offerings based on that search. In contrast, Claim 1 is directed to a method of assigning a product to a product category.

Bailey describes a product procurement system where the user is able to search for an item inside a product database based on certain characteristics of the item, without knowing specific query rules. The product procurement system stores individual items in a database which contains tables characterizing the items such as the "keyword table", "characteristic table" a "keyword_char" table etc. p6. p59. Thus *Bailey* describes a system where items are already present inside the catalog, assigned to categories and associated with respective product attributes as shown by the category selection process: "As generally indicated at 55 in FIG. 4B, category selection box 52 may display a drop-down menu with one or more available categories or catalogs." paragraph 76 p. 9 *Bailey.* Claim 1 on the other hand, teaches a feature fundamentally different, where a product which is not assigned to a category, is assigned to a category. The Office Action points out "assigning" is different than "associating", and clearly *Bailey* describes a system where products are inherently assigned in catalogs or categories. Furthermore the Office Action asserts that the first data set is "user selection of the item category using the client system" line 7 p.11 Office Action. If the assertion were proper, *Bailey*

would have to teach that based on a one product category a particular product would be assigned to a different category. *Bailey* does not teach or suggest assigning products to categories much less "**based on the first data set, assigning said particular product to a product category.**"

Another feature of Claim 1 not taught or suggested by *Bailey* is "**matching said first data set with a product abstraction based, at least in part, on the product category to which said particular product corresponds.**" *Bailey* is silent with respect to a product abstraction. Therefore Bailey cannot possibly teach or suggest matching a first data set with a product abstraction. Furthermore, even if the Office Action assertion that the first data set reads on "a user selection of the item category using the client system" is proper, combined with a description of product procurement system according to Bailey, Bailey shows that the first data set is matched to a product category, or the first data set is matched to item attributes. Specifically according to Bailey, "In one embodiment for example, after a category of item is specified using a keyword, a list of all or at least a predetermined subset of all attributes for that category of item is displayed to the user." Paragraph 38, p. 3. Bailey shows that if the first data set is read as "a keyword", then the first data set is matched to a category. If the first data set is read as "the category", then the first data set is matched to product attributes for that category. Neither the product category nor the product attributes for that category are product abstractions. Bailey therefore fails to teach matching the first data set with a product abstraction, much less "**matching said first data set with a product abstraction based, at least in part, on the product category to which said particular product corresponds.**"

Based on the foregoing, Bailey fails to teach at least one feature of independent Claim 1 and thus fails to teach all the features of Claim 1. The currently amended Claims 3 and 23, as well as dependent Claims 2-46, contain all the limitations of independent Claim 1. Because it

was shown that independent claim contains features not taught by the cited prior art reference

reconsideration and removal of these rejections is respectfully requested.
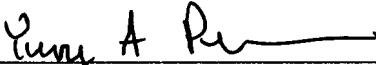
For the reasons set forth above, it is respectfully submitted that all of the pending claims

are now in condition for allowance. Therefore, the issuance of a formal Notice of Allowance is

believed next in order, and that action is most earnestly solicited.

The Examiner is respectfully requested to contact the undersigned by telephone if it is

believed that such contact would further the examination of the present application.

Please charge any shortages or credit any overages to Deposit Account No. 50-1302.

Respectfully submitted,

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on ~~June 27, 2007~~   by _Tracy Reynolds_

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